



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/551,616

10/17/2006

Gerald Sugerman

VOC 424US

5702

61650 7590 06/02/2008

MYERS WOLIN, LLC
100 HEADQUARTERS PLAZA
North Tower, 6th Floor
MORRISTOWN, NJ 07960-6834

EXAMINER

MRUK, BRIAN P

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@myerswolin.com

Office Action Summary	Application No. 10/551,616	Applicant(s) SUGERMAN ET AL.	
	Examiner Brian P. Mruk	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's amendment filed February 28, 2008. Applicant has amended claims 1, 7, 8, and 10-15. Claims 9 and 16-20 have been cancelled. New claims 21-25 have been added. Currently, claims 1-8, 10-15 and 21-25 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 20071128.
3. The objection of claims 7-12 and 20 for being dependent upon another multiple dependent claim is withdrawn in view of applicant's amendments and remarks.
4. The objection of claim 15 for being a substantial duplicate of claim 1 is maintained for the reasons of record.
5. The rejection of claim 6 under 35 U.S.C. 112, second paragraph, for containing the phrase "essentially nonvolatile" is maintained for the reasons of record.
6. The rejection of claims 15 and 16 under 35 U.S.C. 112, second paragraph, for containing the phrase "specifically delineated herein" is withdrawn in view of applicant's amendments and remarks.

7. The rejection of claim 16 under 35 U.S.C. 112, second paragraph, for insufficient antecedent basis for the term “matter” is withdrawn in view of applicant’s cancellation of claim 16.

8. The rejection of claims 1-6 and 13-15 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Long, U.S. Patent No. 4,873,014, is maintained for the reasons of record.

9. The rejection of claims 1-2, 5-6, and 13-15 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Belcak et al, U.S. Patent No. 3,954,648, is maintained for the reasons of record.

10. The rejection of claims 1-2, 5-6, and 13-15 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagoshi et al, U.S. Patent No. 5,958,298, is withdrawn in view of applicant’s amendments and remarks.

NEW GROUNDS OF REJECTION

Claim Objections

11. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Specifically, the examiner asserts that claim 1 has been amended to recite that the composition is “essentially nonvolatile”, which makes claim 6 an improper dependent claim for failing to further limit the subject matter of claim 1.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-8 and 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the examiner cannot find support for the limitation “wherein the ratio of the compound of formula A to the compound of formula B is in the range of from 47:53 to 70:30” that is recited in newly amended claim 1. It is noted by the examiner that Table I of the instant specification does not support the limitation “wherein the ratio of the compound of formula A to the compound of formula B is in the range of from 47:53 to 70:30” that is recited in newly amended claim 1. Appropriate correction and/or clarification is required.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-8, 10-15 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claims 1 and 21 are rejected under 35 U.S.C. 112, second paragraph, for containing the phrase “essentially nonvolatile.” The term “essentially nonvolatile” renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term “essentially nonvolatile”. Furthermore, the specification does not contain guidelines describing what numerical values are encompassed by the phrase “essentially nonvolatile”. Appropriate correction and/or clarification is required.

17. Instant claims 2-8, 10-15 and 22-25 rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a claim with the above addressed 112 problem (i.e. claims 1 and 21). Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Long, U.S. Patent No. 4,873,014.

Long, U.S. Patent No. 4,873,014, discloses a pickling composition comprising a polyalkylene polyamine, such as tetraethylene pentamine (see abstract and col. 2, lines 18-37), a polyglycol, such as polyethylene glycol and polypropylene glycol having molecular weights of 200 and 400 (see col. 2, line 38-col. 3, line 5), hydrochloric acid (see col. 3, lines 31-35), and water (see col. 3, line 35), per the requirements of the instant invention. Specifically, note Examples 1-2. The examiner asserts that the

compositions disclosed in Long would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Long contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Therefore, instant claims 21-25 are anticipated by Long, U.S. Patent No. 4,873,014.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

21. Claims 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Belcak et al, U.S. Patent No. 3,954,648.

Belcak et al, U.S. Patent No. 3,954,648, discloses a composition for removing enamels, acrylics, epoxys, primers and other coatings from surfaces (see col. 1, lines 36-40) comprising alkylamines (see col. 2, lines 27-48), an alcohol, such as polyethylene glycol and triethylene glycol (see col. 3, lines 1-24), and adjunct ingredients, such as surfactants, thickeners, sequestrants, and corrosion inhibitors (see col. 5, lines 2-52), per the requirements of the instant invention. Specifically, note the Examples disclosed in Tables I-III. The examiner asserts that the compositions disclosed in Belcak et al would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Belcak et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise.

Therefore, instant claims 21-25 are anticipated by Belcak et al, U.S. Patent No. 3,954,648.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

22. Claims 21-25 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nagoshi et al, U.S. Patent No. 5,958,298.

Nagoshi et al, U.S. Patent No. 5,958,298, discloses an anti-corrosive draining agent comprising a glycol ether, such as tripropylene glycol monobutyl ether (see abstract and col. 3, lines 44-52), an amine compound, such as 3-aminopropyl morpholine (see col. 4, lines 4-20), and adjunct ingredients, such as surfactants (see col. 4, lines 21-28), per the requirements of the instant invention. Specifically, note Examples 1-17. The examiner asserts that the compositions disclosed in Nagoshi et al would inherently meet the pH requirements of the instant invention, since the compositions disclosed in Nagoshi et al contain all of the required components in the amounts required in the instant claims, absent a showing otherwise. Therefore, instant claims 21-25 are anticipated by Nagoshi et al, U.S. Patent No. 5,958,298.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce

the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

Response to Arguments

23. Applicant's arguments filed February 28, 2008 have been fully considered but they are not persuasive.

Applicant argues that the phrase “essentially nonvolatile” is clearly defined in the specification in paragraph [0022]. However, the examiner respectfully disagrees. Specifically, paragraph [0022] of the instant specification recites, “The term “essentially nonvolatile” refers to the characteristic that the substance at issue is essentially of low volatility, or alternatively essentially meets or exceeds one or more of the following volatility criteria, and as such, is considered of a nonvolatile nature: 1) United States Environmental Protection Agency (EPA) Method 24; 2) American Society for Testing Materials (ASTM) Method D 3960; 3) has a vapor pressure 0.1 mm Hg at ambient temperature.” The examiner maintains that the phrases “is essentially of low volatility” and “essentially meets” in the definition of the phrase “essentially nonvolatile” renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrases “is essentially of low volatility” and “essentially meets”. Furthermore, the specification does not contain guidelines describing what numerical values are encompassed by these phrases.

Applicant further argues that Long, U.S. Patent No. 4,873,014, requires 30-35% by weight of HCl, which is not required in the instant claims. However, the examiner

Art Unit: 1796

respectfully disagrees. Specifically, the instant claims, as presently written, do not exclude HCl.

Applicant further argues that Belcak et al, U.S. Patent No. 3,954,648, requires the presence of a caustic agent, which is excluded in the instant claims. . However, the examiner respectfully disagrees. Specifically, for the reasons mentioned above, the examiner maintains that the phrase “essentially nonvolatile” renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the term “essentially nonvolatile”. Therefore, the examiner asserts that it is not clear what amounts of “essentially nonvolatile, caustic free” are excluded from the instant claims.

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1796

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian P Mruk/
Primary Examiner, Art Unit 1796

Brian P Mruk
May 21, 2008

Brian P Mruk
Primary Examiner
Art Unit 1796